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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,175	02/11/2002	Hans-Peter Koch	10191/2245	5019
7590 10/12/2005 KENYON & KENYON One Broadway New York, NY 10004			EXAMINER HUSON, MONICA A	
			ART UNIT 1732	PAPER NUMBER

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DW

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/074,175

Applicant(s)

KOCH ET AL.

Examiner

Monica A. Huson



Art Unit

1732

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 8-11 and 24.
Claim(s) objected to: _____.
Claim(s) rejected: 1-7, 12-23 and 25-28.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.




Continuation of 3. NOTE: The incorporation of claim 28 (previously rejected under 35 USC 112) into claim 14 presents new issues for possible rejection of the amended claim 14 under 35 USC 112 (1st paragraph).

Continuation of 11. does NOT place the application in condition for allowance because:

With regard to the rejections based on 35 USC 112 (1st paragraph), applicant contends that claims 1-7, 12, 13, and 28 (now cancelled) do, in fact, fully comply with the 112 (1st paragraph) requirements. However, upon reconsideration, the examiner maintains the rejections. Applicant contends that the previous Office Action did not address whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation. This is not persuasive applicant's disclosed experiment involves Kenolube (Specification, Page 6, lines 1-3, Page 8, lines 6-9), which is a thermoplastic material (See US 6534564, column 12, lines 2-4 for support that Kenolube is a thermoplastic material.). Further, the specification discloses a process using materials contain[ing] little or no more organic compounds compared to pressed parts made of polymer-bonded, soft magnetic composites" (Specification, Page 5, lines 11-14). It is again noted that "little or no more organic compounds" does not necessarily indicate a total lack of organic materials, just "little or no more" that comparable items. Additionally, the specification notes that oligoamides can be used an auxiliary pressing agent (Specification, Page 5, lines 27-31); oligoamides are thermoplastic materials (See US 5543489's abstract for support that oligoamides are thermoplastic materials.). It is believed that the undue experimentation necessary would involve experimentation using materials, wherein none of which are thermoplastic.

With regard to the rejections based on 35 USC 103(a), applicant contains that despite the rejections stated in the Office Action, the claims are patentable for the same reason argued in Applicant's response filed 28 February 2005. In response to these arguments, the examiner also restates her position as originally noted in the Office Action mailed 19 May 2005 (See pg. 7).



MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER